

REMARKS/ARGUMENTS

Claims 1 and 3-39 are pending in this application. By this Amendment, Applicant amends Claims 1 and 21.

Claims 6, 11-20, 25 and 30-39 have been withdrawn from further consideration as being directed to non-elected species. Applicant respectfully submits that Claims 1 and 21 are generic. Since non-elected Claims 6, 11-20, 25 and 30-39 depend upon generic Claims 1 and 21, Applicant respectfully requests that the Examiner rejoin and allow Claims 6, 11-20, 25 and 30-39 when generic Claims 1 and 21 are allowed.

Claims 1, 3, 4, 8, 10, 21-23, 27 and 29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Applicant's Admitted Prior Art Figure 8 (AAPA). Claims 5, 7, 9, 24, 26 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Bird et al. (U.S. 5,831,810). Applicant respectfully traverses the rejections of claims 1, 3-5, 7-10, 21-24 and 26-29.

Claim 1 has been amended to recite:

A multilayer ceramic substrate with a cavity comprising:
a multilayer composite member including a plurality of ceramic layers disposed one on another;
a cavity formed in the multilayer composite member such that an opening of the cavity is located in at least one principal surface of the multilayer composite member;
a bottom-surface conductive film connected to a ground potential, the bottom-surface conductive film being disposed on a bottom surface of the cavity;
a plurality of conductive films disposed in the multilayer composite member; and
an electronic component electrically connected to the bottom-surface conductive film, the electronic component being disposed in the cavity; wherein

among the plurality of conductive films, the conductive film which is disposed closest to the bottom-surface conductive film is arranged in the multilayer composite member so as to define a capacitor conductive film which faces the bottom-surface conductive film via at least one of the plurality of ceramic layers to produce a

capacitance, the capacitor conductive film being arranged such that a space between the bottom-surface conductive film and the capacitor conductive film is smaller than a space between all of the other conductive films of the plurality of conductive films and the capacitor conductive film; and

an area of the capacitor conductive film is smaller than an area of the bottom-surface conductive film, and the capacitor conductive film is symmetrically arranged with respect to a center of the electronic component disposed in the cavity, where the center is defined in a bottom surface direction of the cavity. (emphasis added)

Applicant's Claim 21 recites features that are similar to the features recited in Applicant's Claim 1, including the above-emphasized features.

The Examiner alleged that AAPA teaches all of the features recited in Applicant's Claims 1 and 21.

Claim 1 has been amended to recite the features of "among the plurality of conductive films, the conductive film which is disposed closest to the bottom-surface conductive film is arranged in the multilayer composite member so as to define a capacitor conductive film which faces the bottom-surface conductive film via at least one of the plurality of ceramic layers to produce a capacitance, the capacitor conductive film being arranged such that a space between the bottom-surface conductive film and the capacitor conductive film is smaller than a space between all of the other conductive films of the plurality of conductive films and the capacitor conductive film" and "an area of the capacitor conductive film is smaller than an area of the bottom-surface conductive film, and the capacitor conductive film is symmetrically arranged with respect to a center of the electronic component disposed in the cavity, where the center is defined in a bottom surface direction of the cavity." Claim 21 has been similarly amended. Support for these features is found, for example, in the third and fourth full paragraphs on page 10 and Fig. 1 of the originally filed application.

First, as clearly seen in Prior Art Fig. 8 of AAPA, the conductive film 10, which the Examiner alleged corresponds to the capacitor conductive film recited in Applicant's

Claims 1 and 21, is disposed closer to the conductive film 9 than to the bottom-surface conductive film 13. In other words, a space between the bottom-surface conductive film 13 and the capacitor conductive film 10 is **larger than** a space between the other conductive film 9 and the capacitor conductive film 10. Thus, AAPA certainly fails to teach or suggest the features of “among the plurality of conductive films, the conductive film which is disposed closest to the bottom-surface conductive film is arranged in the multilayer composite member so as to define a capacitor conductive film which faces the bottom-surface conductive film via at least one of the plurality of ceramic layers to produce a capacitance, the capacitor conductive film being arranged such that a space between the bottom-surface conductive film and the capacitor conductive film is **smaller than** a space between all of the other conductive films of the plurality of conductive films and the capacitor conductive film” (emphasis added) as recited in Applicant’s Claim 1, and similarly in Applicant’s Claim 21.

Second, AAPA fails to teach or suggest anything at all about the specific area of the capacitor conductive film 10 with respect to the area of the bottom-surface conductive film 13 or about the location or arrangement of the capacitor conductive film 10 with respect to the electronic component 8 disposed in the cavity 7, and certainly fails to teach or suggest the features of “an area of the capacitor conductive film is smaller than an area of the bottom-surface conductive film, and the capacitor conductive film is symmetrically arranged with respect to a center of the electronic component disposed in the cavity, where the center is defined in a bottom surface direction of the cavity” as recited in Applicant’s Claim 1, and similarly in Applicant’s Claim 21.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 1 and 21 under 35 U.S.C. § 102(b) as being anticipated by AAPA.

The Examiner relied upon Bird et al. to allegedly cure a deficiency of AAPA. However, Bird et al. clearly fails to teach or suggest the features of “among the plurality

of conductive films, the conductive film which is disposed closest to the bottom-surface conductive film is arranged in the multilayer composite member so as to define a capacitor conductive film which faces the bottom-surface conductive film via at least one of the plurality of ceramic layers to produce a capacitance, the capacitor conductive film being arranged such that a space between the bottom-surface conductive film and the capacitor conductive film is smaller than a space between all of the other conductive films of the plurality of conductive films and the capacitor conductive film” and “an area of the capacitor conductive film is smaller than an area of the bottom-surface conductive film, and the capacitor conductive film is symmetrically arranged with respect to a center of the electronic component disposed in the cavity, where the center is defined in a bottom surface direction of the cavity.” as recited in Applicant’s Claim 1, and similarly in Applicant’s Claim 21. Thus, Applicant respectfully submits that Bird et al. fails to cure the deficiencies of AAPA described above.

Accordingly, Applicant respectfully submits that AAPA and Bird et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in Applicant’s Claims 1 and 21.

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1 and 21 are allowable. Claims 3-5, 7-10, 22-24 and 26-29 depend upon Claims 1 and 21, and are therefore allowable for at least the reasons that Claims 1 and 21 are allowable.

In addition, non-elected claims 6, 11-20, 25 and 30-39 depend upon generic Claims 1 and 21. Accordingly, Applicant respectfully requests that the Examiner rejoin and allow non-elected Claims 6, 11-20, 25 and 30-39.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

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To the extent necessary, Applicant petitions the Commissioner for a Three-Month Extension of Time, extending to December 21, 2006, the period for response to the Office Action dated June 21, 2006.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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